

**Remarks/Arguments:**

**I. Status**

The Office Action dated March 11, 2005 (the "Office Action") restated the non-final rejection mailed on September 24, 2004, without substantively examining the effect of the amendments presented by the Applicants in the Amendment dated December 21, 2004. Nonetheless, it is the Applicants' understanding based upon a telephone conference with the Examiner on June 14, 2004 that the previously presented amendments have been entered. Therefore, the Examiner's attention is respectfully directed to the amendments and remarks made in the Amendment dated December 21, 2004 for the Applicants' response to the rejections in the Office Action based upon 35 U.S.C. § 101, 35 U.S.C. § 112 and the warning regarding duplicative claims.

Accordingly, claims 1-13 were previously canceled. Claims 14, 18 and 21 have been amended in this Amendment. Thus, claims 14-27 are pending in this application. Reconsideration of this application, as amended, is respectfully requested.

**II. The Rejection of Claims 14, 15 and 17 under 102(e) Has Been Overcome.**

In the Office Action, claims 14, 15 and 17 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2003/0061566 A1 to Rubstein et al. (hereinafter "Rubstein"). The claims, as amended, are distinguishable over Rubstein.

### The Definition of "e-mail"

The Examiner noted that the Information Disclosure Statement relied upon by the Applicants for the definition of "e-mail" in the Amendment dated December 21, 2004 was not available. The Applicants mistakenly omitted including the IDS with the Amendment dated December 21, 2004. Accordingly, the previously omitted IDS is included herewith so as to provide a complete record.

Nonetheless, in the Office Action the Examiner provided evidence that "e-mail" is defined as "the exchange of text messages and computer files over a communications network". (Office Action at page 4). Accordingly, while this definition is broader than the definitions provided in the Applicants' IDS, and broader than the systems discussed in the present specification, the Applicants concur with the definition of "e-mail" given by the Examiner.

### The Present Invention

The present invention was described in detail in the Amendment dated December 21, 2004 and the description is herein incorporated by reference. In summary, the present invention relates to the appending of an advertisement or advertisement retrieval means to an e-mail. More specifically, an email addressed to a recipient is transmitted from a first client computer without the advertisement. The advertisement (or a link to an advertisement) is then appended to the email prior to the email being delivered to the recipient at a second client computer.

Rubstein

Rubstein discloses a process for dynamically integrating two or more digital files. (Rubstein at Abstract). In accordance with Rubstein, a user logs into a website using a first client computer and selects a card for purchase. (Id. at paragraph 37). The user makes modifications (selecting design, message segment and media content) to the card file 46 and provides information such as payment method. (Id. at paragraph 37). The user then downloads the card file 46 to the purchaser's computer. (Id. at paragraph 37). Alternatively, the card file 46 may be e-mailed to the purchaser. (Id. at paragraph 37). Prior to delivery of the card file 46 to the purchaser, the system of Rubstein dynamically integrates an advertisement 54 into the card file 46. (Id. at paragraph 39, FIG. 3). After the card file 46 is downloaded to the first client computer, the purchaser further personalizes the card. (Id. at paragraph 38). Subsequently, the card file 46, which already includes the advertisement 54, is e-mailed from the first client computer to a second client computer. (Id. at paragraph 38).

Therefore, in accordance with the above described process, the advertisement is appended to the card file *prior to any transmission* of the card file from the first client computer. Thus, this embodiment does not disclose an advertisement being appended to an e-mail *after* the e-mail is sent from the first client computer.

Rubstein discloses a second process for the personalization of the card file 46. In accordance with the second process, the card file 46 is not downloaded to the first client computer. Rather, the purchaser customizes the card file *at the vendor's server*. (Id. at paragraph 41, emphasis added). After the card has been personalized, "the card is sent to the recipient from the server as an attachment to an e-mail." (Id. at paragraph 41).

Alternatively, a link is sent to the recipient who can download the card file by invoking the link. (Id. at paragraph 41).

Therefore, according to the second process of Rubstein, there are two communication sessions involved. In the first communication session, data is sent from the purchaser to the vendor's server. The addressees in this communication session are the purchaser and the vendor server. There is no advertisement appended to any of the messages during this communications session.

During the second communication session, the vendor server sends a message to the "recipient" of the card. The message from the vendor server to the recipient is not, however, the same as any of the messages from the purchaser to the vender server. Rather, the message from the vender server to the recipient merely includes data that was transmitted from the purchaser to the vender server. For example, Rubstein states that the *server* sends the card, which was generated at the server, "directly to the recipients designated by the purchaser". (Rubstein at paragraph 41). Therefore, the data to personalize the card and to identify the recipient was sent from the purchaser to the vender server. (Rubstein at paragraph 41). The only message that is addressed to the recipient, however, is the email that includes the advertising.

Thus, Rubstein does not disclose appending advertisements (or links) to messages sent from a first client computer to a second client computer after transmitting the message from the first computer and prior to the delivery of the message to the second client computer.

*Discussion Regarding Patentability of Claim 14*

1. Claim 14

Claim 14, as amended, recites:

A method for generating revenue using electronic mail, comprising the steps of:  
transmitting an e-mail message addressed to at least one email recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of an e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;

appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;

transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of the at least one e-mail recipient; and

displaying the e-mail message on the second client computer, wherein when the e-mail message is first displayed on the second client computer the advertisement software retrieval means is operable at the second client computer to retrieve at least one of the advertisements retrievably stored in the database for display with the e-mail message on the second client computer.

Claim 14, as amended, thus recites a method wherein an e-mail message addressed to a recipient is transmitted from a first client computer through an intermediate computer to a second client computer. The e-mail message is appended with advertisement retrieval software after transmission from the first computer but before displaying the e-mail message on the second client computer.

2. Rubstein Does Not Disclose Appending an E-mail After Transmission

The Examiner alleged that Rubstein discloses transmitting an e-mail from a first client computer through a host server to a recipient. (Office Action at page 4). Claim 14, as amended, clarifies that the *same* message is 1) sent *to a recipient* address without advertisement retrieval software and 2) delivered to *the recipient* address at a second client computer with advertisement retrieval software appended. Rubstein does not disclose these limitations

Specifically, the Examiner has taken the position that the communication used to order, personalize and send the personalized greeting card as disclosed by Rubstein is a

single e-mail message, citing to Rubstein at paragraph 41. As discussed above, however, in the embodiment cited by the Examiner, there are no messages that are addressed *to the recipient* from the purchaser. Rather, the recipient's address is passed to the vender's server as data. The only message that is addressed to the recipient, is the email from the vender server *that includes the advertisement*. Thus the messages that are transmitted without an advertisement (from the purchaser to the vender server) are never appended with advertisements and the messages that include advertisements (emails from the vender server to the recipient) are never transmitted without the advertisements.

In accordance with Rubstein, one message is sent to a recipient without advertisement retrieval software and a *different* message is sent to a *different* recipient at a second client computer with advertisement retrieval software appended. Two different messages to two different recipients are not the same as a single message to a single recipient.<sup>1</sup>

Anticipation under 35 U.S.C. § 102 is proper only if the prior art reference discloses each and every element of the claim. Accordingly, because claim 14 recites a method of transmitting an e-mail addressed to a recipient without advertisement retrieval software and appending the advertisement retrieval software prior to delivery of the message to the second client computer and Rubstein does not disclose any such method, the Applicants submit that claim 14 is patentable over the prior art.

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<sup>1</sup> As noted in the prior Amendment, Rubstein identifies the sending of a card from the server to the recipient as the "post office function". Specifically, Rubstein states that "[t]he server provides a post office function as it can send the personalized card file directly to the recipient designated by the purchaser." (Rubstein at paragraph 41). Thus, it is only the message from the vender server to the recipient that is implicated in performing the "post office function:". Therefore, this function does not support a determination that a message between the server and the purchaser is further sent to a recipient.

*Discussion Regarding Patentability of Claims 15 and 17*

The Examiner has rejected claims 15 and 17 based upon the same prior art discussed above with respect to claim 14. Claims 15 and 17 depend from claim 14 and include the same limitations discussed above with respect to claim 14. Therefore, for at least the same reasons set forth above with respect to claim 14, claims 15 and 17 are allowable over the prior art.

**III. The Rejection of Claims 18 and 19 under 103(a) Has Been Overcome.**

In the Office Action, claims 18 and 19 were rejected under 35 U.S.C. 103(a) as being obvious over Rubstein. The Applicants respectfully submit that in view of the foregoing amendments, the rejection under 35 U.S.C. 103(a) has been overcome.

*Discussion Regarding Patentability of Claim 18*

1. Claim 18

Claim 18, as amended recites:

A method for sending e-mail messages appended with advertising, comprising the steps of:

- storing an identifier for an entity selected by an e-mail user;
- transmitting an e-mail message addressed to at least one email recipient from a first client computer to a host server through at least one computer network, wherein the e-mail message comprises an e-mail address of the e-mail user, an e-mail address of the at least one e-mail recipient, a subject, and a body;
- appending advertisement retrieval software means to the e-mail message transmitted from the first client computer, wherein the advertisement retrieval software means comprises information about at least one of a plurality of advertisements retrievably stored in a database;
- transmitting the e-mail message from the host server to a second client computer through the at least one computer network based upon the e-mail address of at least one e-mail recipient;
- displaying the e-mail message on the second client computer;
- retrieving at least one of the plurality of advertisements retrievably stored in the database for display with the e-mail message on the second client computer; and
- accounting for a contribution to the entity identified by the stored identifier.

Claim 18 as amended, thus recites a method wherein an e-mail message is addressed to a recipient and transmitted from a first client computer through an intermediate computer to a second client computer. The e-mail message is appended with advertisement retrieval software after transmission from the first computer but before arriving at the destination address of the email message. Claim 18 further recites a step of accounting for a contribution to an entity identified by a user.

2. Rubstein Does Not Disclose the Claimed Accounting

As amended, claim 18 includes the step of accounting for a contribution to an entity identified by an e-mail user. Although Rubstein discusses *charging a fee* to advertisers, Applicant is not aware of any teaching or suggestion in Rubstein of an accounting for a *contribution to* an entity identified by the e-mail user. Billing an advertiser is not the same as crediting the account of an identified entity. Therefore, it is respectfully submitted that claim 18 as amended is patentable over the cited prior art.

3. The Discussion of Claim 14 Applies to Claim 18

The Examiner rejected claim 18 based primarily upon Rubstein, further alleging that inclusion of information related to the preferred charitable organization of the e-mail user was obvious. Claim 18, as amended, recites limitations wherein an e-mail message is transmitted from a first client computer through an intermediate computer to a second client computer. The e-mail message is appended with advertisement retrieval software after transmission from the first computer but before arriving at the destination address of the email message. This recitation is similar to the recitation discussed above with



respect to claim 14. Accordingly, even if Rubstein is modified to include information about an e-mail user's preferred charitable organization, the modification does not arrive at the invention of claim 18 as amended. Therefore, under MPEP § 2143.03, the rejection of claim 18 under 35 U.S.C. 103(a) should be withdrawn.

4. There is no Motivation for the Proposed Modification

The Examiner has stated that because 1) charitable giving is related to income and stock ownership and because 2) income and stock ownership reads on receiving proceeds, that it would be obvious to make the proposed modification. (Office Action at page 6). However, the Examiner has failed to allege why, even assuming such allegations are true, one of ordinary skill in the art would *want* to make the proposed modification.

Accordingly, even if the two factual allegations made by the Examiner are true, a motivation for the proposed modification has not been alleged. Therefore, under MPEP § 2143.03, a *prima facie* case of obviousness has not been presented and the rejection of claim 18 under 35 U.S.C. 103(a) should be withdrawn.

5. Conclusion

For any or all of the foregoing reasons, it is respectfully submitted that the rejection of claim 18 as being obvious over Rubstein has been overcome and/or successfully traversed, and the Applicants respectfully submit that the rejection of claim 18 under 35 U.S.C. § 103 should be withdrawn.

*Discussion Regarding Patentability of Claim 19*

The Examiner has rejected claim 19 based upon the same modification of Rubstein and the same arguments discussed above with respect to claim 18. Claim 19 depends from claim 18 and includes all of the limitations of claim 18 as amended. Therefore, for at least the same reasons set forth above with respect to claim 18, claim 19 is allowable over the prior art.

**IV. Conclusion**

Applicants respectfully request entry of the amendments and favorable consideration of the application.

A prompt and favorable action on the merits is requested.

Respectfully Submitted,  
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